

### **REMARKS**

Claims 1-23 and 26-32 are currently pending in the present application. By this Amendment, claims 1, 20, 22, 26, and 32 have been amended, no claims have been cancelled, and no new claims have been added. Thus, claims 1-23 and 26-32 are at issue. Applicants respectfully request reconsideration and withdrawal of the Examiner's rejections.

#### **A. Interview Summary of April 18, 2006, Telephone Interview**

Applicants' attorney held a brief telephone interview with the Examiner on April 18, 2006, seeking clarification of the present Office Action. The Office Action was discussed in relation to the pending independent claims. In the Interview, the Examiner stated that the second-to-last sentence of paragraph 12 should read, "... if the applicant amends the claims to say that the member is at first position that is at a different angle than a second position of the member ..." The Office Action inadvertently recited "handle" instead of "member." The Examiner also indicated to the undersigned attorney that amending the claims according to this statement in the Office Action would overcome the rejections based on the Fleming references. Applicants have responded to the Office Action in accordance with this understanding.

#### **B. Rejections Over Allemann**

In paragraph 3 of the Office Action, the Examiner rejected claims 1-10, 17, 18, 20-23, and 32 under 35 U.S.C. § 103(a), as being unpatentable over U.S. Patent No. 4,109,494 to Allemann ("Allemann"). Applicants traverse the Examiner's rejections.

It is the burden of the Patent and Trademark Office to establish a *prima facie* case of obviousness when rejecting claims under 35 U.S.C. §103. *In re Reuter*, 210 U.S.P.Q.2d 249 (CCPA 1981). To establish a *prima facie* case of obviousness, three basic criteria must be met: first, there must be some suggestion, incentive or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art references must teach or suggest all the claim limitations. *See In re*

*Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1988). Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Applicants submit that Allemann does not disclose, teach, or suggest all the limitations of claims 1-10, 17, 18, 20-23, and 32, and further, that the prior art provides no motivation to modify Allemann to create the invention recited in claims 1-10, 17, 18, 20-23, and 32. Accordingly, the Examiner has not set forth a *prima facie* case of obviousness with respect to claims 1-10, 17, 18, 20-23, and 32.

**1. Claims 1-10, 17, and 18**

Claim 1 includes, among other elements, “wherein the handle is operably and adjustably connected to the member such that the first position of the handle when the member is in the first position is the same as the first position of the handle when the member is in the second position.” Allemann does not disclose, teach, or suggest this element of claim 1.

Allemann discloses a locking or latching mechanism for a door (10) that provides for simultaneous retraction of a latch bolt member (20) and a dead bolt member (23) by turning the knob (21,22). (Allemann, Col. 2, Lines 51-60). The dead bolt member (23) is also independently operable by turning a thumb turn (24) that is connected to a flat tail piece (57) to operate the dead bolt (23). (Allemann, Col. 3, Lines 32-42). The mechanism of Allemann can be used with either a right-hand (FIGS. 1-5) or left-hand mounting (FIGS. 7-8). (Allemann, Col. 4, Lines 60-68; Col. 5, Lines 1-12). In the left-hand mounting configuration (See FIG. 8), both the thumb turn (24) and tail piece (57) are rotated 90° from their positions in a right-hand mounting configuration (See FIG. 2). Allemann does not disclose, teach, or suggest any variation from this configuration for left-hand mounting.

First, as acknowledged by the Examiner, Allemann does not disclose, teach, or suggest a that the thumb turn (24) is in the same position when the tail piece (57) is in the position for right-hand mounting and when the tail piece (57) is in the position for left-hand mounting. But claim 1 also requires that “the handle is operably and adjustably connected to the member,” to result in this positional relationship. Allemann does not disclose that the thumb turn (24) is

adjustably connected to the tail piece (57). In fact, since the tail piece (57) in Allemann is “press fit” into the thumb turn (24), it results in a rigid connection. The thumb turn (24) is certainly not adjustably connected to the tail piece (57). Significantly, in the Examiner’s illustrated modification (Attachment #2 to the Office Action), changing the position of the thumb turn also changes the position of the tail piece (57) to the same position (vertical) as in a right-hand configuration. Therefore, even the Examiner’s proposed modification of Allemann still does not recite all the elements of claim 1. Thus, Allemann does not disclose, teach, or suggest this element of claim 1.

The Examiner asserts that it would be obvious to one of ordinary skill in the art to modify Allemann to provide for the thumb turn (24) being in the same position when the tail piece (57) is in either the first or second positions, since it is considered as a design consideration within the art that will not affect the latch mechanism.” However, the Examiner’s cited motivation is not sufficient to form a *prima facie* case of obviousness. First of all, the Examiner’s argument overlooks the fact that claim 1 also recites that the handle is “adjustably connected to the member.” The Examiner cites no motivation in the prior art to make the thumb turn (24) adjustable with respect to the tail piece (57), and Applicants submit that there is no such motivation provided. Such a modification is clearly more than a simple design change, as the Examiner asserts. Additionally, Allemann teaches away from such a modification. A reference teaches away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). A disclosure that teaches away from, or discourages, the making of the claimed invention undermines a *prima facie* case of obviousness. *In re Spinnoble*, 405 F.2d 578, 587 (C.C.P.A. 1969); *In re Caldwell*, 319 F.2d 254, 256 (C.C.P.A. 1963). Thus, it is improper to modify references where the references teach away from their modification. *In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983). As described above, Allemann discloses that the tail piece (57) in Allemann is press-fit into the thumb turn (24). This simple, non-adjustable press-fit connection would have to be completely changed, possibly by the addition of a separate piece, to make it adjustable. Further, Allemann teaches that changing the position of the tail piece (57), such as

from FIG. 2 to FIG. 8, also changes the position of the thumb turn (24), contrary to the device recited in claim 1. Thus, one of ordinary skill in the art would be discouraged from making the claimed invention upon reading Allemann, and Allemann teaches away from the proposed combination.

Second, the Examiner asserts that such modification is a design consideration that is within the skill in the art. Applicants disagree that changing the position of moving, functional components of a lock mechanism constitutes a simple design consideration. Nevertheless, the Examiner has not provided a motivation for one skilled in the art to modify Allemann to make the invention recited in claim 1. Rather, the Examiner, at most, has only established a general ability to modify the mechanism of Allemann, without citing any motivation to reach the specific result of Applicants' invention. "A general incentive does not make obvious a particular result, nor does the existence of techniques by which those efforts can be carried out." *In re Deuel*, 51 F.3d 1552, 1559 (Fed. Cir. 1995). A statement that modifications of the prior art would have been within the ordinary skill of the art is not sufficient to establish a *prima facie* case of obviousness without a specific objective reason to combine or modify the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). The prior art provides no specific motivation to modify Allemann to reach Applicants' invention, and the Examiner has cited none. The Examiner has merely used Applicants' invention as an instruction manual or template to modify the teachings of the prior art in an attempt to render the claimed device obvious, which constitutes improper hindsight reconstruction. *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988). Thus, the Examiner has not established the required motivation to modify Allemann, and the Examiner has not established a *prima facie* case of obviousness with respect to claim 1.

Claims 2-10, 17, and 18 depend from claim 1 and contain all the elements of claim 1. Thus, for the reasons set forth above with respect to claim 1, the Examiner has not established a *prima facie* case of obviousness with respect to claims 2-10, 17, and 18.

## **2. Claims 20 and 21**

Claim 20 includes, among other elements, “the handle being operably and adjustably connected to the member when the member is in one of the member first position and the member second position, such that the first position of the handle when the member is in the first position is the same as the first position of the handle when the member is in the second position.” Allemann does not disclose, teach, or suggest this element of claim 20. This element is similar to the element discussed above with respect to claim 1, in that it requires, “the first position of the handle when the member is in the first position is the same as the first position of the handle when the member is in the second position,” and, “the handle being operably and adjustably connected to the member.” As discussed above with respect to claim 1, Allemann does not disclose, teach, or suggest either of these features. Accordingly, for the same reasons set forth above with respect to claim 1, Allemann does not disclose, teach, or suggest all elements of claim 20.

Additionally, the Examiner has provided no motivation to modify Allemann to reach the invention recited in claim 20. Applicants’ arguments set forth above with respect to claim 1 apply equally to claim 20. Thus, the Examiner has not provided the required motivation to modify Allemann, and has not established a *prima facie* case of obviousness with respect to claim 20.

Claim 21 depends from claim 20 and contains all the elements of claim 20. Thus, for the reasons set forth above with respect to claim 20, the Examiner has not established a *prima facie* case of obviousness with respect to claim 21.

## **3. Claims 22 and 23**

Claim 22, as amended, includes, among other elements, “a member operably and adjustably connected to the handle ... such that the first position of the handle when the member is adapted to be connected to the lock assembly in the first configuration is the same as the first position of the handle when the member is adapted to be connected to the lock assembly in the second configuration.” Allemann does not disclose, teach, or suggest this element of claim 22.

This element is similar to the element discussed above with respect to claim 1, in that it requires, “the first position of the handle when the member is adapted to be connected to the lock assembly in the first configuration is the same as the first position of the handle when the member is adapted to be connected to the lock assembly in the second configuration,” and “a member operably and adjustably connected to the handle.” As discussed above with respect to claim 1, Allemann does not disclose, teach, or suggest either of these elements. Accordingly, for the same reasons set forth above with respect to claim 1, Allemann does not disclose, teach, or suggest all elements of claim 22.

Additionally, the Examiner has provided no motivation to modify Allemann to reach the invention recited in claim 22. Applicants’ arguments set forth above with respect to claim 1 apply equally to claim 22. Thus, the Examiner has not provided the required motivation to modify Allemann, and has not established a *prima facie* case of obviousness with respect to claim 22.

Claim 23 depends from claim 22 and contains all the elements of claim 22. Thus, for the reasons set forth above with respect to claim 22, the Examiner has not established a *prima facie* case of obviousness with respect to claim 23.

#### **4. Claim 32**

Claim 32 includes, among other elements, “the handle is operably and adjustably connected to the tailpin such that the first position of the handle when the tailpin is in the first position is the same as the first position of the handle when the tailpin is in the second position.” Allemann does not disclose, teach, or suggest this element of claim 32. This element is similar to the element discussed above with respect to claim 1. As discussed above with respect to claim 1, Allemann does not disclose, teach, or suggest either of these features. Accordingly, for the same reasons set forth above with respect to claim 1, Allemann does not disclose, teach, or suggest all elements of claim 32.

Additionally, the Examiner has provided no motivation to modify Allemann to reach the invention recited in claim 32. Applicants’ arguments set forth above with respect to claim 1 apply equally to claim 32. Thus, the Examiner has not provided the required motivation to

modify Allemann, and has not established a *prima facie* case of obviousness with respect to claim 32.

**C. Rejections Over Allemann in View of Fayerman**

In paragraph 4 of the Office Action, the Examiner rejected claims 11-16 under 35 U.S.C. § 103(a), as being unpatentable over Allemann in view of U.S. Patent No. 4,453,753 to Fayerman *et al.* (“Fayerman”). Applicants traverse the Examiner’s rejections.

Claims 11-16, through dependency from claim 1, include, among other elements, “wherein the handle is operably and adjustably connected to the member such that the first position of the handle when the member is in the first position is the same as the first position of the handle when the member is in the second position.” As stated above with respect to claim 1, Allemann does not disclose, teach, or suggest this element of claim 1, and the Examiner has provided no motivation to modify Allemann to reach the claimed invention. Fayerman also does not disclose this element of claim 1. Fayerman does not disclose any mechanism by which the disclosed door latch is adapted to be used in doors having either a left-hand or right-hand mounting configuration. Further, Fayerman provides no motivation to modify the cited references to make the invention recited in claim 1. Indeed, the Examiner does not point to any such disclosure or any such motivation in Fayerman. Thus, for the reasons set forth above with respect to claim 1, the Examiner has not made a *prima facie* case of obviousness with respect to claims 11-16.

**D. Rejections Over Allemann in View of Flinn**

In paragraph 5 of the Office Action, the Examiner rejected claim 19 under 35 U.S.C. § 103(a), as being unpatentable over Allemann in view of U.S. Patent No. 299,633 to Flinn (“Flinn”). Applicants traverse the Examiner’s rejection.

Claim 19, through dependency from claim 1, includes, among other elements, “wherein the handle is operably and adjustably connected to the member such that the first position of the handle when the member is in the first position is the same as the first position of the handle

when the member is in the second position.” As stated above with respect to claim 1, Allemann does not disclose, teach, or suggest this element of claim 1, and the Examiner has provided no motivation to modify Allemann to reach the claimed invention. Flinn also does not disclose this element of claim 1. Flinn discloses only a doorknob and spindle, and thus does not disclose any mechanism by which a door latch is adapted to be used in doors having either a left-hand or right-hand mounting configuration. Further, Flinn provides no motivation to modify the cited references to make the invention recited in claim 1. Indeed, the Examiner does not point to any such disclosure or any such motivation in Flinn. Thus, for the reasons set forth above with respect to claim 1, the Examiner has not made a *prima facie* case of obviousness with respect to claim 19.

**E. Rejections Over Allemann in View of Fleming ‘089**

In paragraph 6 of the Office Action, the Examiner rejected claims 26-29 under 35 U.S.C. § 103(a), as being unpatentable over Allemann in view of U.S. Patent No. 4,671,089 to Fleming *et al.* (“Fleming ‘089”). Applicants traverse the Examiner’s rejections.

Claim 26 includes, among other elements, “an adapter adjustably connecting the handle and the member, such that the first position of the handle when the member is in the first position is the same as the first position of the handle when the member is in the second position.” Allemann does not disclose, teach, or suggest this element of claim 26. This element is similar to the element discussed above with respect to claim 1, in that it requires, “the first position of the handle when the member is in the first position is the same as the first position of the handle when the member is in the second position.” As stated above with respect to claim 1, Allemann does not disclose, teach, or suggest this element. Additionally, Alleman does not disclose, “an adapter adjustably connecting the handle and the member.” As stated above with respect to claim 1, Alleman does not disclose that the handle and the member are adjustably connected. Therefore, Alleman cannot and does not disclose an adapter to make such an adjustable connection. Fleming ‘089 also does not disclose the above element of claim 26.

Fleming ‘089 discloses a latch mechanism (12) and a deadbolt mechanism (16). The deadbolt mechanism (16) contains a thumb turn (26) connected to an actuator blade (87) that



extends into a drive sleeve (88) to move a yoke (89) and extend/retract the deadbolt. (Fleming '089, Col. 6, Lines 50-56; Col. 7, Lines 3-17). The thumb turn (26) also has a squared portion (101) that interacts with two leaf springs (100) to releasably retain the thumb turn (26) in the vertical or horizontal position. (Fleming '089, Col. 7, Lines 48-59). Fleming '089 does not disclose a method to mount the deadbolt mechanism (16) in either a left-hand or right-hand configuration. However, since the actuator blade (87) is vertical in the unlocked position (see FIG. 14), it is doubtful that the actuator blade (87) would be anything but vertical if mounted in an opposite configuration. Thus, Fleming '089 does not disclose a device in which "the first position of the handle when the member is in the first position is the same as the first position of the handle when the member is in the second position."

Additionally, Fleming '089 does not disclose that the thumb turn (26) is adjustably connected to the blade (87), and thus, does not disclose an adapter which forms such an adjustable connection. The Examiner asserts that the squared portion (101) of the thumb turn is such an adapter. However, the squared portion (101) is only designed for interaction with the leaf springs (100), and Fleming '089 does not disclose, teach, or suggest that it serves to adjustably connect the thumb turn (26) with the blade (87). In fact, the squared portion (101) is integral with the thumb turn (26), and receives the blade (87) in a non-adjustable rectangular slot. (See FIG. 19). Thus, it is clear that the squared portion (101) cannot adjustably connect the thumb turn (26) with the blade (87). Accordingly, Fleming '089 also does not disclose, teach, or suggest the above element of claim 26, and the proposed combination of Allemann and Fleming '089 does not disclose, teach, or suggest all the elements of claim 26.

The Examiner has provided no motivation to modify Allemann or Fleming '089 to reach the invention recited in claim 20. Applicants' arguments set forth above with respect to claim 1 apply equally to claim 26. Fleming '089 also does not provide the required motivation to modify the mechanisms of Allemann and/or Fleming '089 to reach Applicants' claimed design. Like Allemann, Fleming '089 provides no motivation to adjustably connect the thumb turn (26) with the blade (87) or to connect the thumb turn (26) with the blade (87) so that the thumb turn (26) is in the same position while the blade (87) is in a different position. Also like Allemann, Fleming '089 teaches away from such a modification, because, as discussed above, Fleming '089 teaches

that the thumb turn (26) and the blade (87) are rigidly connected. Further, since Fleming '089 does not disclose an adapter to adjustably connect the thumb turn (26) and the blade (87), it cannot provide any motivation to modify Alleman or Fleming '089 to contain such a feature. Indeed, the Examiner does not provide any of the required motivations in the Office Action. Thus, the Examiner has not provided the required motivation to modify the cited references, and has not established a *prima facie* case of obviousness with respect to claim 26.

**F. Rejections Over Allemann in View of Fleming '089 and Flinn**

In paragraph 7 of the Office Action, the Examiner rejected claims 30 and 31 under 35 U.S.C. § 103(a), as being unpatentable over Allemann in view of Fleming '089 and Flinn. Applicants traverse the Examiner's rejections.

Claims 30 and 31, through dependency from claim 26, include, among other elements, "an adapter adjustably connecting the handle and the member, such that the first position of the handle when the member is in the first position is the same as the first position of the handle when the member is in the second position." As stated above with respect to claim 26, the proposed combination of Allemann and Fleming '089 does not disclose, teach, or suggest this element of claim 26, and the Examiner has provided no motivation to modify Allemann or Fleming '089 to reach the claimed invention. Flinn also does not disclose this element of claim 26. Flinn discloses only a doorknob and spindle, and thus does not disclose any mechanism by which a door latch is adapted to be used in doors having either a left-hand or right-hand mounting configuration. Further, Flinn provides no motivation to modify the cited references to make the invention recited in claim 26. Indeed, the Examiner does not point to any such disclosure or any such motivation in Flinn. Thus, for the reasons set forth above with respect to claim 26, the Examiner has not made a *prima facie* case of obviousness with respect to claims 30 and 31.

**G. Rejections Over Fleming '089 in View of Fleming '144 and Other References**

In paragraph 8 of the Office Action, the Examiner rejected claims 1-10, 17, 18, 20-23, 16-29, and 32 under 35 U.S.C. § 103(a), as being unpatentable over Fleming '089 in view of U.S. Patent No. 5,092,144 to Fleming *et al.* ("Fleming '144"). In paragraph 9 of the Office Action, the Examiner rejected claims 11-16 under 35 U.S.C. § 103(a), as being unpatentable over Fleming '089 in view of Fleming '144 and Fayerman. In paragraphs 10 and 11 of the Office Action, the Examiner rejected claims 19, 30, and 31 under 35 U.S.C. § 103(a), as being unpatentable over Fleming '089 in view of Fleming '144 and Flinn. Applicants have amended the claims consistent with the Examiner's statements made in paragraph 12 of the Office Action, and consistent with the April 18, 2006, interview, to overcome these rejections. Applicants respectfully request the Examiner to withdraw the rejections.

**H. Reply to Examiner's "Response to Arguments"**

In paragraph 12 of the Office Action, the Examiner states, "[T]he applicant fails to amend the claims according to what the examiner discuss [sic] in the interview. The examiner was clear that the rejection in view of Fleming '089, as modified by Fleming '144 was going to be withdrawn if the applicant amends the claims to say that the handle is at first position that is at a different angle than a second position of the handle, according to the explanation given by the examiner." Applicants' attorney respectfully submits that this is incorrect. During the interview, the Examiner instructed Applicants' attorney to amend the claims to indicate that the second position of the member is different from the first position of the member. Consistent with this instruction, Applicants amended the claims accordingly in the November 22, 2005, Reply to Office Action. Indeed, in the Examiner's Interview Summary Document (PTOL-413), the Examiner specifically states that "[T]he examiner propose [sic] the applicant to incorporate the limitation that when the member is in the second configuration, the second position of the member is different from the position at the first configuration as seen in Figures 3 and 4, wherein in the first configuration (right hand door) is in a first position and in the second configuration (left hand door) is in a different position [emphasis added]." Thus, Applicants'

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attorney previously amended the claims according to the Examiner's instructions.

Notwithstanding the above, Applicants' attorney has now amended the claims in accordance with the Examiner's statements made in the present Office Action and the April 18, 2006, telephone interview.


**CONCLUSION**

In view of the foregoing, Applicants respectfully request reconsideration of the Examiner's rejections and allowance of claims 1-23 and 26-32 in the present Application. Applicants submit that the Application is in condition for allowance and respectfully requests an early notice of the same.

Respectfully submitted,

Dated: May 2, 2006

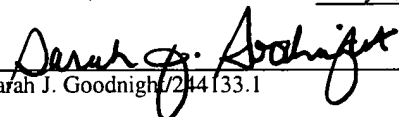
By: \_\_\_\_\_

  
Paul J. Nykaza, Reg. No. 38,984  
Wallenstein Wagner & Rockey, Ltd.  
311 South Wacker Drive, 53<sup>rd</sup> Floor  
Chicago, Illinois 60606-6630  
312.554.3300

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**CERTIFICATE UNDER (37 C.F.R. § 1.8a)**

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Mail Stop Amendment, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 2, 2006.

  
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Sarah J. Goodnight/244133.1